

## **REMARKS**

### **I. OBJECTION TO THE SPECIFICATION**

The Examiner on pages 2-3 listed numerous informalities and also noticed that trademarks have not been properly identified in the specification. Applicant thanks the Examiner for the thorough review. Applicant has made all the requested amendments (plus a few more). Applicant thus respectfully requests the withdrawal of the objection to the specification.

### **II. CLAIM OBJECTIONS**

The Examiner on page 4 objected to claims 2 and 8 based on typo informalities. Applicant again thanks the Examiner for the thorough review. Applicant has amended claims 2 and 8 as requested by the Examiner and thus requests for the withdrawal of this rejection.

### **III. CLAIM REJECTION – 35 USC § 101**

The Examiner on page 4 states “[c]laims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” Applicant has amended the claims and, while not admitting that the original claims were directed towards non-statutory subject matter, respectfully asserts that the amended claims now clearly show the invention is directed towards statutory subject matter.

In particular, all of the preambles and steps in the independent claims (1, 7, 13 and 19) have been amended to explicitly recite that the steps are performed by a Facilitator’s web site. This removes any argument that the claims may be abstract ideas or performed in one’s head.

Further, all the independent claims (1, 7, 13 and 19) include, *inter alia*, the limitations of the “Internet” and a “Registry.” The Internet and Registries are described in the specification and are well known to those of ordinary skill in the art. The Internet and Registries comprise sophisticated electrical and communication systems that perform well known functions and therefore may reasonably be considered, *albeit* very large and complex, particular apparatuses. Thus, the amended claims are directed towards statutory subject matter under *in re Beliski* which permits method claims tied to a particular apparatus. With the amendments, all claims are now tied to at least two different particular apparatuses (Internet and Registry) and are thus statutory subject matter.

In addition to the “Internet” and a “Registry”, claims 7 and 13 have been amended to also include the limitation of a “hosting server,” *i.e.* another particular apparatus. Hosting servers are well known in the art and perform the known function of providing the particular resources necessary to host a web site. Thus, in addition to the reasons previously stated, this rejection should be withdrawn for claims 7 and 13.

### **III. CLAIM REJECTION – 35 USC § 103**

The Examiner on page 5 states “[c]laims 1-19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Go Daddy in view of Chauchard.” Applicant has amended the claims and traverses this rejection.

The Examiner on page 6 of the OA states:

Go Daddy does not teach step C, assisting in trademarking a name, whether a domain name or otherwise as claimed. However, Chauchard does (paragraphs 75-80). Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectations of success. (emphasis added)

Applicant respectfully disagrees that Go Daddy and Chauchard make the claimed invention obvious because Chauchard teaches away from the claimed invention and does not disclose a Facilitator’s web site assisting an Entrepreneur in trademarking a domain name or label with the USPTO for the following reasons.

1. Chauchard teaches using a local computer (in contrast to the claimed Facilitator’s web site) to prepare a trademark application.

All of the amended independent claims state that: 1) it is the Facilitator’s web site that performs the various claimed steps in the process, and 2) the Facilitator’s web site is accessible to a plurality of Entrepreneurs over the Internet. Thus, the Facilitator’s web site cannot be a local computer since local computers are generally not accessible to a plurality of people over the Internet.

In contrast, Chauchard teaches that the trademark applications are prepared by a local computer. Chauchard [0001] states “[t]he present invention relates to a process for preparing a

trademark application, using a local computer capable of being connected to a remote computer by a computer network of the Internet type.” (emphasis added)

In addition, Chauchard’s abstract states:

Process for preparing a trademark application, by means of a local computer capable of being connected to a remote computer via a computer network of the Internet type, including the following steps, performed on the local computer:

- (i) entering the trademark,
  - (ii) selecting the products or services to which the trademark applies,
  - (iii) validating the entry and the selection,
  - (iv) sending the validated entry and selection to the remote computer via the computer network,
- said steps being carried out in the order indicated. (emphasis added)

Since a “local computer” preparing a trademark application (Chauchard) teaches away from a “Facilitator’s web site” performing the claimed steps (claims 1, 7, 13 and 19), Applicant respectfully submits that Chauchard teaches away from the claimed invention and thus cannot be combined with another reference to make the claimed invention obvious.

2. Chauchard teaches the local computer sends the trademark application to a remote computer.

In addition, Chauchard teaches that its local computer sends “the validated entry and selection to the remote computer via the computer network.” (abstract step (iv)) (emphasis added) The remote computer is described in several places in Chauchard as:

[0037] This remote computer can be installed on the premises of a member of the Compagnie Nationale des Conseils en Propriété Industrielle or on those of a computer company.

[0042] Said other, remote computer can be installed on the premises of a member of the Compagnie Nationale de la Propriété Industrielle.

[0140] According to another variant of each of the foregoing examples, the remote computer is capable of sending messages to a second remote computer by electronic mail; it is thus possible to re-transmit the validated entry and selection to the second computer, together with information contained in the user account; when this information, accompanied by the validated entry and selection, is sufficient, preparation of the trademark filing case is complete; it may then be appropriate for it to be revised by a member of the Compagnie Nationale des Conseils en Propriété Industrielle.

[0141] This is facilitated when the remote computer, or the second remote computer, is installed on the premises of the intellectual property attorney. (emphasis added)

Chauchard's "remote computer", i.e. the computer receiving the validated entry and selection, is described in paragraph [0141] as being "installed on the premises of the intellectual property attorney." Thus, Chauchard has defined its "remote computer" in such a way that it clearly does not teach or include an official government trademark office.

Critically, Chauchard also teaches that the patent application should be sent to a "remote computer" where it can be reviewed by a member of the Compagnie Nationale des Conseils en Propriété Industrielle whose members, presumably, are intellectual property and/or trademark attorneys. These teachings can be found in paragraphs [0004]-[0014]. Paragraphs [0006] and [0013] are particularly telling and state:

[0006] First of all, it is essential, prior to the filing of the application, to carry out availability searches to avoid infringing the rights of third parties; the performance and interpretation of such searches are tasks that are extremely complex, owing to the prior rights of varying relevance that may exist, for example among the corporate names or among trademarks already filed.

[0013] A clear understanding of the applicant's objectives can be obtained when the latter has recourse to the services of specialist consultants.

Chauchard teaches that "it is essential" to perform various complex searches "prior to the filing the [trademark] application." Chauchard also teaches the advantages of having "the services of specialist consultants" which are available if the "remote computer" is "installed on the premises of the intellectual property attorney." Chauchard's "remote computer" thus clearly teaches away from being an official government trademark office due to all of the problems mentioned in paragraphs [0004]-[0014].

Chauchard's "local computer" cannot be considered a "Facilitator's web site" and Chauchard's "remote computer" actively teaches away from being an official government trademark office. Thus, neither Go Daddy nor Chauchard, individually or together, teach a "Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet." Go Daddy, as admitted by the Examiner, does not even teach a trademarking system and Chauchard's trademarking process is just too different from the claimed process for all the reasons previously stated for their combination to make the claimed process obvious. Applicant thus respectfully requests the withdrawal of this rejection and the allowance of all pending claims (1-19).

## CONCLUSION

Applicant respectfully submits that Go Daddy and Chauchard do not teach all the claim limitations and that Chauchard actively teaches away from the claimed invention as explained above. Applicant thus requests the allowance of all pending claims, i.e. claims 1-19, as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorneys for Applicants at the telephone number or email address listed below.

Respectfully submitted,

**The Go Daddy Group, Inc.**

Date: 1/29/2009

By:           /Stewart J. Womack/            
Stewart J. Womack  
Reg. No. 45,230  
Attorney for Applicant

The Go Daddy Group, Inc.  
14455 N. Hayden Road, Suite 219  
Scottsdale, AZ 85260  
480.505.8832  
SWomack@GoDaddy.com